REMARKS

In the Office Action mailed August 18, 2008, the Examiner maintained the rejection of all claims 1-25 and 29-30 under 35 U.S.C. § 103(a) as being unpatentable over Barclay (Publication 2003/0119522) in view of Hussain (Publication 2002/0037750). Applicant reviewed the cited art and requests reconsideration in view of the remarks below.

Applicant submits that the teachings within the cited art do not reasonably or logically lead to the claimed invention as defined by independent claims 1, 22 and 29. Claim 1 recites:

(1) "in a client station, detecting a request to initiate a voice call," and

(2) "responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service, wherein the message indicates a location granularity preference of a user of the client station."

Claims 22 and 29 recite similar language.

The teachings cited by the Examiner do not encompass the claimed invention. Applicant asks the Examiner to review the responses to the Office Actions mailed January 18, 2006, February 8, 2007, and January 29, 2008 for a detailed analysis of the Barclay and Hussain references, and for reasons why the combination of the Barclay and Hussain references fall short of describing the claimed invention. Applicant reiterates a portion of that analysis below.

Barclay teaches a customer setting up a profile with his service provider to indicate his location granularity preferences. Hussain teaches detecting a call and then initiating a dual communication that includes a voice and a data portion, neither of which include location granularity information. The Examiner attempted to combine Barclay with Hussain to render the following functions obvious: "in a client station, detecting a request to initiate a voice call," and "responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service, wherein the message indicates a location granularity

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preference of a user of the client station". Particularly, the Examiner asserted that Hussain teaches the timing of sending the message in response to detecting a call and Barclay teaches the content of the message. However, combining teachings of a user setting up a profile as in Barclay, with generic teachings of sending a notification into the network as in Hussain, does not encompass the present claims.

A.   The teachings of the asserted combination of references would not lead a person of ordinary skill in the art to achieve the claimed invention

Barclay discloses a system in which a user first sets up his personal profile that indicates his preferences for the ability of others to access his location and the granularity of location information to be given. (para. [0011], [0016-0018]). The profile information is stored in a customer profile. (para. [0016]-[0018], Fig. 3). Subsequently, when a call is placed by a customer, the service provider retrieves the customer's preset options from the customer profile to provide the parties to the call with the customer's location. (para. [0019]-[0020], Fig. 4). Specifically, Figure 4 is a flowchart showing a method of sending location information and at step 407, the location format and granularity is obtained from customer profiles by the provider.

The Examiner stated that Barclay teaches "sending to a called party at a first location, a telephone call from a calling party having a second location and while the **telephone call** is in progress selecting a granularity value from among a predetermined set of granularity values." (Office Action, p. 2). The fact that such information is determined during the telephone call is not relevant to the claims. Rather, claim 1 recites "in a client station, detecting a request to initiate a voice call," and "responsive to the request, sending from the client station into a network a message … ." Thus, in claim 1, prior to the telephone call occurring, the client station sends the granularity information into the network.

Barclay does not teach the client station sending into a network a message indicating a location granularity preference of a user of the client station in response to detecting a request to initiate a voice call, as in claims 1, 22 and 29. The Examiner cited to Hussain as teaching the step of detecting a request to initiate a voice call, and for sending a notification message along with the call initiation message, and asserted that the combination of Hussain and Barclay renders the present claims obvious. Applicant disagrees.

Hussain teaches a signal exchange for providing location information of mobile equipment (ME) to a Police System Emergency Terminal (PSET). Hussain teaches that when the ME detects that a preselected number was dialed, the ME sends a notification to the network that includes dialed digits, time of call, and location of the ME. (para. [0134]-[0142]; abstract).

The proposed combination of Barclay and Hussain to arrive at the claimed invention is objectively nonsensical because a person of ordinary skill in the art faced with that teaching would not want to combine the references in the manner asserted by the Examiner. Within Barclay, the user's location granularity preferences are stored in a customer profile at the service provider. Thus, in response to a request to initiate a call, it would not make sense for the client station in Barclay to *again* send the user's location granularity preferences to the service provider because the service provider already has this information. To send the information to the service provider, using the notification method as taught by Hussain, would render the invention within Barclay unnecessary. The point of the invention in Barclay is to establish user's preferences during a subscription procedure, so that the service provider maintains the information.

Because the teachings of the references in combination would not lead a person of ordinary skill in the art to make the asserted combination, the asserted combination does not render the present claims obvious.

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B. **The proposed modification of the combination of references would change the principle of operation of the prior art invention being modified**

The Examiner stated that it would have been obvious to one of ordinary skill to modify the device of Barclay et al. by adding a feature to enhance system performance so that a notification message is sent along with the call initiation message as taught by Hussain et al. However, as described above, because the network in the invention of Barclay already has the granularity information stored in a profile, it would not make sense to send the information again within a "notification message". Alternatively, to change the operation of the method in Barclay such that the information is sent in a "notification message" instead of being stored within a profile would change the principle of operation of the invention in Barclay because Barclay is directed to an invention for establishing a profile and retrieving information from the profile (Figures 4 and 5). If the proposed modification or combination of references would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. (MPEP §2143.01(VI)).

CONCLUSION

Applicant submits that all pending claims are in condition for allowance over the cited references. Applicant notes that the present Office Action is the 8th Office Action issued for the patent application. Due to the lengthy prosecution of this application, Applicant requests the Examiner to call the undersigned below at (312) 913-3331 if the Examiner has any uncertainties about issuing a Notice of Allowance.

Respectfully submitted,
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Dated: November 12, 2008   By: /Joseph A. Herndon/
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